

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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S/N 10/764,739

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): Michael P. Connelly

Examiner: Frank Leiva

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Title: GAMING DEVICE HAVING INDEPENDENTLY SELECTED
CONCURRENT AUDIO

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on December 10, 2010, from the Final Rejection of claims 1-37 of the above-identified application, as set forth in the Office Action mailed on June 10, 2010.

This Appeal Brief is accompanied by a Petition, as well as the appropriate fee, to obtain a two-month extension of the period for responding to the Notice of Appeal to the Board of Patent Appeals and Interferences, thereby moving the deadline for response from February 10, 2011 to April 10, 2011.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

I. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, WMS Gaming Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on January 26, 2004 with claims 1-37. In response to a Non-Final Office Action mailed on June 18, 2007, Appellant amended claims 1, 16, 19, 34, and 37 and claims 1-37 remained pending. In response to the Final Office Action mailed on November 28, 2007, Appellant amended claims 1, 19, and 37 and claims 1-37 remained pending. In response to the Non-Final Office Action mailed April 29, 2008, Appellant amended claims 1, 19, and 37 and claims 1-37 remained pending. A Final Office Action was mailed December 29, 2008 and an Advisory Action was mailed on March 20, 2009. In response to the Non-Final Office Action mailed on August 12, 2009, Appellant amended claim 19 and claims 1-37 remained pending. A Final Office Action was mailed on June 10, 2010. Claims 1-37 stand at least twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated June 10, 2010.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This Summary of Claimed Subject Matter is provided with citations to specific locations in the specification and figures of the present application. Due to the specificity of these citations, as should be readily understood, full understanding of the subject matter of the citations may require the context of the surrounding paragraphs and figure elements. Further, this summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellants refer to each of the appended claims and its legal equivalents for a complete statement of the invention.

As illustrated, described, and claimed in the present application, aspects of the present inventive subject matter include, but are not limited to, systems and methods of and for gaming devices having independently selected concurrent audio.

INDEPENDENT CLAIM 1

1. A computerized gaming system, comprising: **FIG. 1; page 3, lines 5 – 12.**

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a wagering game on which monetary value can be wagered; and **FIG. 1; page 2, lines 11 – 14; page 3, line 5 – page 4, line 9.**

an audio module, the audio module operable to play an audio track, the audio track comprising a plurality of selected audio element tracks that are played at the same time to create the played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game machine based on at least one of random selection and a randomly ordered list. **FIG. 2; FIG. 3; Page 4, lines 1-29; page 5, lines 1-10.**

INDEPENDENT CLAIM 19

19. A method of providing audio from a computerized gaming system, comprising:
determining by one or more processors a key for an audio portion of a wagering game;

Page 6, lines 1-28.

selecting by the one or more processors two or more audio element tracks from a plurality of audio element tracks having the key; **FIG. 3; page 6, lines 1-16.**

playing an audio track, the audio track including the two or more selected audio element tracks that are played at the same time by the computerized gaming system to create the played audio track, wherein the audio element tracks are played in the same key in synchronization and are selected by the wagering game machine based on at least one of random selection and a randomly ordered list, and wherein the audio element tracks are deselected over time by the selection process, the computerized gaming system further operable to conduct a wagering game upon which monetary value can be wagered. . **FIG. 2; FIG. 3; Page 4, lines 1-29; page 5, lines 1-10.**

INDEPENDENT CLAIM 37

37. A computerized gaming system, comprising: **FIG. 1; page 3, lines 5 – 12.**

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a wagering game on which monetary value can be wagered; and **FIG. 1; page 2, lines 11 – 14; page 3, line 5 – page 4, line 9.**

an audio module, the audio module comprising a plurality of audio element tracks, wherein selected audio element tracks are played at the same time to create a played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game machine, and wherein the audio element tracks are selected and deselected over time based on at least one of random selection and a randomly ordered list. . **FIG. 2; FIG. 3; Page 4, lines 1-29; page 5, lines 1-10.**

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-37 are rejected under 35 U.S.C. § 102(a) as being anticipated by Hecht et al. (US 2003/0073489 A1).

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §102(a)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P* § 2131. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

B) Discussion of the rejection of claims 1-37 under 35 U.S.C. § 102(a) as being anticipated by Hecht et al. (US 2003/0073489 A1; hereinafter “Hecht”).

Claims 1-37 were rejected under 35 U.S.C. § 102(a) as being anticipated by Hecht. Appellant respectfully traverses the rejections and submits that the claims recite elements not found in Hecht and are therefore patentable.

For example, independent claim 1 recites an audio module of a computerized gaming system that is operable to select audio element tracks that are played at the same time, wherein the “selected audio element tracks comprise two or more instruments played in the same key in synchronization.” Independent claims 19 and 37 recites similar language. The Office Action states that Hecht, at paragraphs [0009], [0043] and [0050] describes the recited subject matter. Appellant respectfully disagrees. Paragraphs [0009] and [0043] of Hecht do not make any reference to keys or selecting track elements having the same key. Paragraph [0050] references keys, but rather than selecting track elements having the same key as claimed, Hecht describes the opposite where a track having a *different* key is selected or created. In particular, paragraph

[0050] states that “if a player makes input W, the gaming device plays the same song in key D and then stops playing the song in key C.” This is consistent with paragraphs [0015] and [0060] of Hecht which also state that a key is *changed*. At no point in the specification does Hecht describe selection of audio tracks having the same key for synchronous playback at the same time as provided in each of independent claims 1, 19, and 37.

Further, the Office Action in the Response to Arguments section on page 3 asserts paragraph [0052] of Hecht as providing a teaching of the synchronized playback of audio tracks at the same time. Appellant respectfully traverses this assertion with regard to paragraph [0052]. In particular, the language of independent claim 1 provides, “an audio module ... operable to play an audio track ... comprising a plurality of selected audio element tracks that are played at the same time to create the played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization.” This portion of independent claim 1 is with regard to playing the two or more selected audio element tracks that are in the same key at the same time. Cited paragraph [0052] of Hecht instead describes transitioning from one audio track to another.

For example, paragraph [0052] of Hecht states, “[W]hen the CPU makes a change from playing an initial sound recording to a variant of that sound recording, the change can be timed so that the transition is not on-beat, or the change timed so that the variant sound recording is generated on-beat with the initial recording.” Paragraph [0052] continues to describe how a “suitable software metronome or metronome program” are utilized to make sound changes on-beat according to a check-back rate. Then, “[u]sing the check-back rate, the CPU detects sounds causing events and simultaneously plays a new sound recording on-beat with an initial sound recording.” Note that the playing of the “new sound” is the change described in the first sentence of paragraph [0052]. This first sentence of paragraph [0052] is a change from playing the initial sound recording to the variant, or new, sound recording. Thus, when the change is made, as described in paragraph [0052], the new sound is played and the initial recording is not. Thus, the “simultaneous plays” language doesn’t mean the initial sound recording and the variation of that sound recording are played “at the same time” as claimed. Instead, paragraph [0052] of Hecht describes a simultaneous transition between the initial sound recording and the variation of that sound recording. This meaning attributed to the word “simultaneously” in

paragraph [0052] is supported by paragraph [0051]. (“When the CPU changes from playing one sound recording to another, the CPU can stop the first sound recording at one point in time and start the second sound recording at the same point in time (e.g., simultaneously).”) The simultaneous reference to tracks in Hecht is therefore not a reference to playing the tracks at the same time.

Hecht does describe in the last sentence of paragraph [0051] a fade-in and fade-out between two sounds recordings and this may be a concurrent playing of the sound recordings for a brief period. However, this would not be a playing of the sound recordings at the same time in the same key as claimed. The sound recordings described in Hecht, as discussed above, are not in the same key and instead are described in paragraph [0050] being in *different keys*.

Thus, Appellant respectfully submits that Hecht fails to provide a teaching or suggestion of not only playing a plurality of audio tracks comprising two or more instruments played in the same key, but also playing the plurality of audio tracks in the same key “at the same time” and “in synchronization.” With specific regard to the claims, Appellant respectfully submits that Hecht fails to teach or suggest “an audio module … operable to play an audio track … comprising a plurality of selected audio element tracks that are played at the same time to create the played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization” as in independent claim 1 and similarly in independent claims 19 and 37. Accordingly, Appellant respectfully submits that independent claims 1, 19, and 37 are patentable.

Claims 2-18 and 20-36 depend, directly or indirectly, from patentable independent claims 1 and 19, respectively, and are also patentable for at least the same reasons.

Appellant respectfully requests reversal of the 35 U.S.C. § 102(a) rejections and allowance of claims 1-37.

SUMMARY

For the reasons argued above, claims 1-37 were not properly rejected under § 102(a) as being anticipated by Hecht. Thus, it is respectfully submitted that the claims are patentable over Hecht. Reversal of the rejections and allowance of claims 1-37 are respectfully requested.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6938

Date 4/6/2011

By I, James D. Hallenbeck,
James D. Hallenbeck
Reg. No. 63,561

8. CLAIMS APPENDIX

1. A computerized gaming system, comprising:
 - a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a wagering game on which monetary value can be wagered; and
 - an audio module, the audio module operable to play an audio track, the audio track comprising a plurality of selected audio element tracks that are played at the same time to create the played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game machine based on at least one of random selection and a randomly ordered list.
2. The computerized gaming system of claim 1, wherein each audio element track comprises one or more instruments not present in the other audio element tracks.
3. The computerized gaming system of claim 2, wherein at least one audio element track comprising one or more specific instruments comprises multiple phrases independently selectable for playback to create the played audio track.
4. The computerized gaming system of claim 3, wherein the multiple phrases are played back out of sequence to create the played audio track.
5. The computerized gaming system of claim 4, wherein the phrase sequence played back to create the played audio track comprises a randomly selected phrase order.
6. The computerized gaming system of claim 4, wherein the phrase sequence played back to create the played audio track is provided by an ordered list of phrases.

7. The computerized gaming system of claim 4, wherein the phrase sequence played back to create the played audio track comprises a phrase sequence selected based on priority weighting assigned to the phrases.

8. The computerized gaming system of claim 1, wherein two or more audio element tracks are randomly combined to create the played audio track.

9. The computerized gaming system of claim 1, wherein two or more audio element tracks are combined according to a predetermined list of audio element track combinations.

10. The computerized gaming system of claim 1, wherein two or more audio element tracks are selected and combined to produce the played audio track, the selection comprising evaluation of priority weighting of the various audio element tracks.

11. The computerized gaming system of claim 1, wherein the audio element tracks are played back repeatedly, and wherein the length of at least two of the audio element tracks are of different length.

12. The computerized gaming system of claim 1, wherein the played audio track further comprises a portion that is not a combination of audio element tracks.

13. The computerized gaming system of claim 1, wherein at least one of the plurality of audio element tracks is played using at least one randomized parameter, the parameters including at least one of volume, panning, reverb, equalization, compression, distortion, flange, and phase parameters.

14. The computerized gaming system of claim 3, wherein the audio element phrases are sorted into at least two subgroups.

15. The computerized gaming system of claim 14, wherein the audio elements in the phrase subgroups are grouped by compatibility with other audio element phrase groups.
16. The computerized gaming system of claim 1, wherein the audio element tracks have different sampling rates.
17. The computerized gaming system of claim 1, wherein at least one of the audio element tracks comprises music.
18. The computerized gaming system of claim 1, wherein at least one of the audio element tracks comprises sound effects.
19. A method of providing audio from a computerized gaming system, comprising:
determining by one or more processors a key for an audio portion of a wagering game;
selecting by the one or more processors two or more audio element tracks from a plurality of audio element tracks having the key;
playing an audio track, the audio track including the two or more selected audio element tracks that are played at the same time by the computerized gaming system to create the played audio track, wherein the audio element tracks are played in the same key in synchronization and are selected by the wagering game machine based on at least one of random selection and a randomly ordered list, and wherein the audio element tracks are deselected over time by the selection process, the computerized gaming system further operable to conduct a wagering game upon which monetary value can be wagered.
20. The method of claim 19, wherein each audio element track comprises one or more instruments not present in the other audio element tracks.
21. The method of claim 20, wherein at least one audio element track comprising one or more specific instruments comprises multiple phrases independently selectable for playback to create the played audio track.

22. The method of claim 21, wherein the multiple phrases are played back out of sequence to create the played audio track.

23. The method of claim 22, wherein the phrase sequence played back to create the played audio track comprises a randomly selected phrase order.

24. The method of claim 23, wherein the phrase sequence played back to create the played audio track is provided by an ordered list of phrases.

25. The method of claim 23, wherein the phrase sequence played back to create the played audio track comprises a phrase sequence selected based on priority weighting assigned to the phrases.

26. The method of claim 19, wherein two or more audio element tracks are randomly combined to create the played audio track.

27. The method of claim 19, wherein two or more audio element tracks are combined according to a predetermined list of audio element track combinations.

28. The method of claim 19, wherein two or more audio element tracks are selected and combined to produce the played audio track, the selection comprising evaluation of priority weighting of the various audio element tracks.

29. The method of claim 19, wherein the audio element tracks are played back repeatedly, and wherein the length of at least two of the audio element tracks are of different length.

30. The method of claim 19, wherein the played audio track further comprises a portion that is not a combination of audio element tracks.

31. The method of claim 19, wherein at least one of the plurality of audio element tracks is played using at least one randomized parameter, the parameters including at least one of volume, panning, reverb, equalization, compression, distortion, flange, and phase parameters.
32. The method of claim 22, wherein the audio element phrases are sorted into at least two subgroups.
33. The method of claim 32, wherein the audio elements in the phrase subgroups are grouped by compatibility with other audio element phrase groups.
34. The method of claim 19, wherein the audio element tracks have different sampling rates.
35. The method of claim 19, wherein at least one of the audio element tracks comprises music.
36. The method of claim 19, wherein at least one of the audio element tracks comprises sound effects.
37. A computerized gaming system, comprising:
 - a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a wagering game on which monetary value can be wagered; and
 - an audio module, the audio module comprising a plurality of audio element tracks, wherein selected audio element tracks are played at the same time to create a played audio track, wherein the selected audio element tracks comprise two or more instruments played in the same key in synchronization and are selected by the wagering game machine, and wherein the audio element tracks are selected and deselected over time based on at least one of random selection and a randomly ordered list.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.